

REMARKS

The present amendment is responsive to the Office Action of March 11, 2005.

Claims 1, 15 and 29 were rejected as being indefinite. Reconsideration and withdrawal of these rejections are respectfully requested.

As the Examiner will note, the independent claims have been amended so as to positively recite that the two recited historical calculations periods are within the selected calculation period. Moreover, the recitations relating to the comparison method have been removed from the claims. The Examiner's attention to detail in this regard is acknowledged, with thanks.

Claims 1-13, 15-27 and 29-41 were rejected as being unpatentable over Deaton et al. Reconsideration and withdrawal of these rejections are respectfully requested.

Claims 1, 15 and 29, as amended, each recite:

causing the computer to compute a lifecycle factor for the individual customer, the lifecycle factor being computed by determining an absolute value of a difference of the selected measure and by multiplying the determined absolute value with a percentage measure growth of the selected measure, both the difference and the percentage measure growth being determined over two selected historical periods within the selected calculation period

Therefore, according to the claimed embodiment, the lifecycle factor may be computed by multiplying the determined absolute value with a percentage measure growth of the selected measure. Therefore, the claims expressly call for a) the determined absolute value, b) the percentage measure growth and c) the product of a) and b).

The Office identifies the transaction frequency and the dollar volume spent as corresponding to the recited determined absolute value and the recited percentage measure growth of the selected measure. The Office Action states that "Based on the calculated frequency

and dollar volume spent, the system can compute the average dollar amount spent per customer per time interval as well as the percent of the total dollar amount spent per time interval". While the Office Action concedes that the Deaton et al. reference does not expressly teach the recited lifecycle factor, the Office points out that Deaton et al. does disclose computing transaction data for each customer such as frequency and dollar volume for each customer visit. Based upon the frequency and dollar volume disclosed therein, the Office advances that Deaton et al. has readily available the data necessary to compute a) and b) above and thus c). Therefore, the Office contends that it would have been obvious for Deaton et al. to rearrange the disclosed frequency and dollar volume data to determine the absolute value of the difference of the selected measure and to multiply determined absolute value with a percentage measure growth of the selected measure, both the difference and the percentage measure growth being determined over two selected historical periods within the selected calculation period, to thereby obtain the claimed lifecycle factor. This contention is respectfully traversed.

At the outset, §706.02(j) Contents of a 35 U.S.C. 103 Rejection, lists four requirements for a §103 rejection, the third of which states that the Office should state "(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter". The Office has not pointed to any modifications of Deaton et al. that would yield the claimed invention. The Office points to Tables 5 and 6 of Deaton et al. for a teaching of frequency and dollar volume for each customer visit, which the Office intimates can be used to calculate the claimed lifecycle factor. It is respectfully submitted that this is not the case. Table 5 lists the Shopping Frequency per Customer, the Total Customers, the % Customers Shopping per Period, the % Total Customer Base, the Total \$ Spent for Period, the % Total \$ Spent per Period, the Average Check per Visit and the Average \$ Spent per Customer. Table 6 lists the Total

Customers the % Total Customer Base, the Total \$ Spent for Period, the Average Check per Visit, the Average \$ Spent per Customer, the Total Visits per Customer and the Average Visits per Customer.

Nowhere does Deaton et al. teach or suggest an absolute value of a difference of the selected measure determined over two selected historical periods within the selected calculation period, as required by the claims. In fact, no absolute value of any difference is taught or suggested in Deaton et al. – the phrase does not even appear in the patent. Moreover, nowhere do Deaton et al. teach or suggest a percentage measure growth of the selected measure determined over two selected historical periods within the selected calculation period, as also required by the claims. In fact, the term “growth” is wholly absent from this patent – and the growth of a customer over two selected historical periods expressed as a percentage is also wholly untaught and unsuggested by this reference. The Office, moreover has not presented any proposed modifications to Deaton et al. that would yield such values, as required by the Office’s own guidelines as memorialized in the MPEP.

The Office appears to suggest that some undefined re-arrangement of the elements of Tables 5 and 6 of Deaton et al. would yield a) the determined absolute value, b) the percentage measure growth and c) the product of a) and b) to thereby achieve the recited lifecycle factor. In this regard, the Examiner’s attention is drawn to the Office’s own guidelines for formulating a §103 rejection based upon such a rearrangement of parts, at §2144.03:

Rearrangement of Parts

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Here the Office appears to contend that a worker could re-arrange the parts of Tables 5 and 6 (and the frequency and dollar volume measurements) to meet the terms of the independent claims. However, the Office has not advanced any way to effectuate such rearrangement or any motivation or reason for the worker to do so, without benefit of the applicant's claimed embodiment. Here, Deaton et al. has provided no motivation to make the necessary changes to the reference method to meet the terms of the claims. Deaton et al. teach no absolute values of any difference of selected measures and do not teach any growth or percentage growth. Hence, there appears to be no support in Deaton et al. for the Examiner's contention that the applied reference renders the claimed embodiments obvious. Reconsideration and withdrawal of the 35 USC §103(a) rejections of the claims are, therefore, respectfully requested.

As the rejections of the independent claims are believed to have been overcome, it is not believed necessary to discuss the rejection of the dependent claims in any detail at this time.

Applicants' attorney, therefore, respectfully submits that all claims are allowable and that the present application in condition for an early allowance and passage to issue. If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below.

Respectfully submitted,

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